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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,417	01/18/2005	Robert Dickinson	HAS3-68917	5269
7550 12/01/2009				
Fulwider Patton Lee & Utech Howard Hughes Center 6060 Center Drive Tenth Floor Los Angeles, CA 90045			EXAMINER HOLLOWAY III, EDWIN C	
			ART UNIT 2612	PAPER NUMBER
			MAIL DATE 12/01/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/500,417

**Applicant(s)**

DICKINSON ET AL.

**Examiner**

Edwin C. Holloway, III

**Art Unit**

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***EXAMINER'S RESPONSE***

1. In response to the application filed 6-24-2004 with a preliminary amendment, the amendment has been entered and the application has been examined. Claims 21-39 are pending. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's position that the claims are unpatentable for the reasons set forth in this Office action:

***Drawings***

2. Figure 1 is should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because the unlabeled rectangular boxes shown in the drawings should be provided with descriptive text labels See MPEP 608.02, 608.02(b) and 37 CFR 1.84(o). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as “Annotated Sheets” and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
  - (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
  - (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
  - (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
  - (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
  - (f) BACKGROUND OF THE INVENTION.
    - (1) Field of the Invention.
    - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
  - (g) BRIEF SUMMARY OF THE INVENTION.
  - (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
  - (i) DETAILED DESCRIPTION OF THE INVENTION.
  - (j) CLAIM OR CLAIMS (commencing on a separate sheet).
  - (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
  - (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).
5. The disclosure is objected to because of the following informalities: The specification should be amended to include appropriate section headings as listed above. On page 15, line 16, the reference numeral "36" should be --29--.

Appropriate correction is required.

***Claim Objections***

6. Claim 31 is objected to because of the following informalities: Claim 31 refers to "the magnetic pattern" but does not earlier refer to a magnetic pattern. Appropriate correction is required.

***Claim Rejections - 35 USC § 102 & 103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Roseman (GB 2333666).

Regarding claims 21-24, Roseman discloses an apparatus (fig. 1) with a verification means including remotely detectable tag (marker 2) and interrogation means

(reader 4). The reader generates a magnetic field the region of the high permeability and low coercively marker, detects the response and generates an authentication signal to enable or disable actuator 7 to change operation. See the abstract, page 9 line 8 - page 10 line 9 and page 11 lines 16-26.

11. Claims 25, 28-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roseman (GB 2333666) as applied above and further in view of Dames '338 (WO 97/04338).

Dames '338 discloses an magnetic marker tags for carrying multi-bit information. The tags include a first material of low coercivity and a second material of medium/high coercively that is capable of being permanently magnetized with a pattern provides by a read/write head. This provides highly distinctive codes for anti-counterfeiting. See the abstract, page 2 lines 13-28, page 3 line 30 - page 4 line 1, page 6 lines 1-27 and page 7 line 28 - page 8 line 37. Page 33 line 30 includes a laminate corresponding to a protective layer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Roseman the features of claims 25, 28-30 and 32 as taught by Dames '338 to provide highly distinctive codes for anti-counterfeiting.

12. Claims 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roseman (GB 2333666) and Dames '338 (WO 97/04338) as applied above and further in view of Dames '790 (WO 96/31790).

Dames '338 discloses an magnetic marker tags for carrying multi-bit information. The tags include a first material of low coercivity and a second material of medium/high coercivity that is capable of being permanently magnetized with a pattern provides by a read/write head. The tags allow identification and detection of position. The tag can be erased by de-magnetization coil (de-gaussing with AC field) to allow re-programming by a recording head. See the abstract, page 7 lines 16-36 and page 18 liens 4-23.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above a de-magnetization coil as taught by Dames '790 for reprogramming and detection of position.

13. Claims 26, 27 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roseman (GB 2333666) as applied above and further in view of Kurando (EP 0478019).

Kurando discloses a toner cartridge with a magnetic card to allow detection of the type and position of the cartridge to assure proper operation. Modification of operation includes stopping or changing speed. See the abstract, col. 4 lien 45 - col. 6 line 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Roseman the features of claims 26, 27 and 34-36 as taught by Kurando to assure proper operation of a printer/copier.

14. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roseman (GB 2333666) as applied above and further in view of Jung (US 5899674).



Jung discloses surgical cassette with bar code label that can be detected by a surgical instrument to determine the type of cassette and automatically change operating parameters. The instrument may be a pump and the cassette may include an infusion tube. See the abstract, col. 1 lines 31-54, col. 2 lines 53-65 and col. 4 lines 10-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Roseman the features of claims 37-39 as taught by Jung for automatic changing of surgical parameters.

15. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roseman (GB 2333666) as applied above and further in view of Tsimmerman (US 6193510).

Tsimmerman discloses surgical device such as a toothbrush head with a coded label that can be detected by the handle to control operation to assure periodic replacement. See the abstract and col. 1 lines 38-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Roseman the features of claim 33 as taught by Tsimmerman to assure periodic replacement.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wada discloses a toner bottle with indicia for recognizing that it is genuine.

### ***CONTACT INFORMATION***

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman, can be reached on (571) 272-3059.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/1/2009  
(571) 272-3058

/Edwin C. Holloway, III/  
Primary Examiner, Art Unit 2612